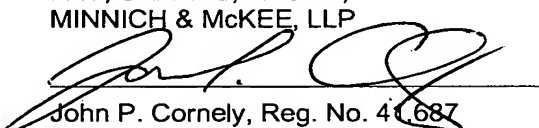
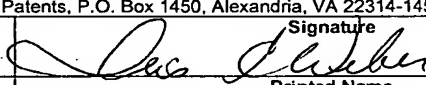
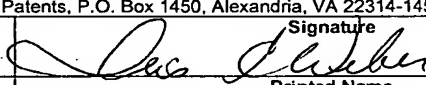
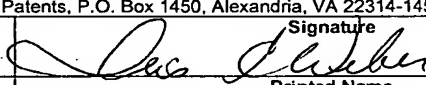


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket No.: LUTZ 2 00079																	
Application No.: 10/087,291		Filed: February 28, 2002																	
Title: SEARCHING DIGITAL CABLE CHANNELS BASED ON SPOKEN KEYWORDS USING A TELEPHONE SYSTEM																			
First Named Inventor: Hua, et al.																			
Art Unit: 2162		Examiner: Isaac M. Woo																	
<p>Applicant(s) request(s) review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). <i>Note: No more than five (5) pages may be provided.</i></p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.</p> <p style="text-align: right;">Respectfully submitted, FAY, SHARPE, FAGAN, MINNICH & McKEE, LLP</p> <p style="text-align: right;"> John P. Cornely, Reg. No. 41,687 1100 Superior Avenue Seventh Floor Cleveland, OH 44114-2579 216-861-5582</p> <p>Date: September 16, 2005</p> <p>NOTE: Signature(s) of all the inventor(s) or assignee(s) of record of the entire interest or their representative(s) is/are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of forms are submitted.</p> <tr><td colspan="4" style="text-align: center;">CERTIFICATE OF MAILING</td></tr> <tr><td colspan="4"><p>I hereby certify that this Pre-Appeal Brief Request for Review and accompanying documents are being</p><p><input checked="" type="checkbox"/> deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: MAIL STOP AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22314-1450.</p><p><input type="checkbox"/> deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22314-1450.</p></td></tr> <tr><td colspan="2">Express Mail Label No.:</td><td colspan="2">Signature </td></tr> <tr><td colspan="2">Date September 16, 2005</td><td colspan="2">Printed Name Iris E Weber</td></tr>				CERTIFICATE OF MAILING				<p>I hereby certify that this Pre-Appeal Brief Request for Review and accompanying documents are being</p> <p><input checked="" type="checkbox"/> deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: MAIL STOP AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22314-1450.</p> <p><input type="checkbox"/> deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22314-1450.</p>				Express Mail Label No.:		Signature 		Date September 16, 2005		Printed Name Iris E Weber	
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Express Mail Label No.:		Signature 																	
Date September 16, 2005		Printed Name Iris E Weber																	

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Office, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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SEP 16 2005 I hereby certify that this paper and/or fee is being deposited with the United States Postal service as First Class Mail service on September 16, 2005 and is addressed to MAIL STOP AF, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Iris E Weber

SEP 19 2005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Hua, et al.

TITLE: **SEARCHING DIGITAL CABLE CHANNELS BASED ON SPOKEN KEYWORDS USING A TELEPHONE SYSTEM**

APPLICATION NO.: 10/087,291

FILED: February 28, 2002

EXAMINER: Isaac M. Woo

ART UNIT: 2162

CONFIRMATION NO.: 3105

LAST OFFICE ACTION: March 16, 2005

ATTORNEY DOCKET NO.: LUTZ 2 00079

Case Name/No. Hua 14-1

REASON(S) FOR REQUESTING PRE-APPEAL BRIEF REVIEW
(ATTACHMENT TO FORM PTO/SB/33)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully submits the following reasons for requesting a pre-appeal brief review of the above-captioned matter.

REMARKS

Applicants have carefully consider the Examiner's comments set forth in the Office Action dated March 16, 2005, and disagree with the rejection of the claims.

Present State of the Claims

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Polish (U.S. Patent No. 6,430,531).

General Overview

The present application is directed to a system and/or method for searching television program listings via a telephone system and outputting the results via a television system. In a suitable embodiment, the search query submitted via the telephone system is at least partially vocalized and interpreted via a voice recognition module.

Polish, on the other hand, is not directed to any kind of system or method that employs a telephone system for input or a television system for output. Should the

examiner feel otherwise, he is clearly misreading or misinterpreting the Polish reference. Polish is directed to a general **bilateral speech system**. Polish proposes a speech processor that both speaks and listens using speech recognizers as well as speech synthesizers to allow a user to engage in a verbal dialog with a database. See, e.g., the Abstract of Polish. See also FIGURE 1 showing the input to the system **101** as "SPEECH" entered into the speech recognizer **103** and the output of the system **101** as "SPEECH" exiting the synthesizer **117**. Moreover, Polish explicitly distinguishes itself from so called unidirectional speech systems, e.g., one which has a speech input but otherwise non-speech output. See, e.g., col. 1, lns. 15-20.

Importantly, Polish never mentions a telephone, telephone network, telephone call or any telephone system whatsoever. Polish also does not disclose a television, a television receiver box, a television system or anything of the like.

The Examiner's Proposed Modification of Polish is Contrary to the Express Teachings of Polish

The Examiner acknowledges that "Polish does not explicitly disclose the search results are displayable." However, he goes on to take the position that such a feature would have been obvious to a person having ordinary skill in the art. Applicants respectfully disagree. First, please note that Polish does not explicitly disclose any type of television, monitor or display device. Second, recall that Polish is specifically directed to a **bilateral speech system**, i.e., having both speech input and speech output, and Polish expressly distinguishes itself from a unilateral speech system, e.g., having a speech input and a displayed output.

Accordingly, Polish itself teaches directly away from the claims which explicitly recite "displayable" search results. MPEP §2145(X)(D)(1) is instructive in this area – "A prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness." As is well settled, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP §2141.02. Furthermore, according to MPEP §2143.01, "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." In this case, the express purpose of the Polish invention is to have a bilateral speech system as opposed to a unilateral speech system, and clearly therefore, modifying the search results output by Polish to be displayable as opposed to spoken, renders the Polish invention unsatisfactory for its intended purpose. That is to say, it thwarts the very purpose of Polish's invention.

Independent Claims 1 Defines Patentably over Polish

Claim 1 calls for “receiving a telephone call from a viewer via a telephone system.” Contrary to the assertions made by the Examiner, Polish fails to expressly teach or fairly suggest the foregoing. Nowhere does Polish even mention a telephone, a telephone call, a telephone network, or any type of telephone system. Polish is completely silent as to this feature. Nowhere does Polish disclose any apparatus, component, function, step, part or any other entity or element that receives a telephone call via a telephone system.

Claim 1 also calls for “sending the search results to a television receiver box of the viewer via a television system such that said search results are displayable upon a television operatively connected to the receiver box.” Polish also does not expressly teach or fairly suggest the foregoing. Again, Polish is completely silent as to this feature. There is no apparatus, component, function, step, part, entity or element disclosed in Polish that sends search results to a television receiver box via a television system. In fact, Polish never even discloses a television receiver box, a television system or a television.

Accordingly, claim 1 defines patentably over the prior art, along with claims 2-10 depending therefrom.

Independent Claim 11 Defines Patentably over Polish

Claim 11 is directed to “a service control point connected to a telephone system and a television system.” The service control point as claimed includes “query generating means for generating a search query in response to a telephone call received from a viewer via the telephone system.” Polish never discloses a service control point that is connected to a telephone system and a television system, nor does Polish disclose the claimed means which generate a query in response to receiving a telephone call via the telephone system. In fact, nowhere in Polish are any means disclosed that receive a telephone call via a telephone system. Additionally, Polish does not disclose a service control point, nor does it disclose a telephone system, nor does it disclose a television system.

Claim 11 also calls for “searching means” that generate “search results which are sent to a television receiver box of the viewer via the television system such that said search results are displayable upon a television operatively connected to the television receiver box.” Again, Polish fails to disclose the claimed means. Nowhere in Polish are any means disclosed which generate search results that are sent to a television receiver box via a television system.

Accordingly, claim 11 defines patentably over the prior art, along with claims 12-20 depending therefrom.

Rebuttal to the Final Office Action

The Examiner's failure to give patentable weight to the recitation of "a service control point connected to a telephone system" is erroneous. While patentable weight may not in certain circumstance be afforded to recitations in the preamble of a claim, this general rule is limited. Moreover, the rule only applies to particular types of recitations or passages within the preamble, and should not be used to dismiss the preamble in its entirety. As the Examiner correctly notes, the general rule applies to language in the preamble only when: (1) "it recites the purpose of a process or the intended use of a structure;" and, (2) "the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone." In the present case, the preamble language at issue satisfies neither of these caveats and accordingly the rule does not apply. Therefore, patentable weight should be accorded to the language in question.

First, the language "a service control point" is not merely some superfluous recitation in the preamble that identifies a purpose of a process or an intended use of a structure. On the contrary, a service control point is the very object of the claim. That is to say, the claim is not directed to a paperclip, a doorknob, a widget or some other random object, rather "a service control point" is being claimed. If the object of the claim itself is to be given no patentable weight, then one might as well claim "any arbitrary thing" in the preamble followed by a list of elements.

Second, the body of the claim does depend on the preamble for completeness, and in particular the body of the claim depends upon the language "connected to a telephone system." Being connected to the telephone system puts the object of the claim (namely, a service control point) in context. Notably, the body of the claim calls for query generating means that receives a telephone call via "the telephone system," i.e., the telephone system recited in the preamble. Clearly, the body of the claim depends on the recitation of "a telephone system" in the preamble. That is to say, the query generating means in the body of the claim does not stand alone apart from the recitation of "a telephone system" in the claim preamble.

The Examiner also points to FIGURE 1 and col. 3, lines 16-25 in support of his contention that Polish "teach[es] that TV program guide displays programs on TV screen." The Examiner is, however, misreading Polish and/or his logic is flawed. FIGURE 1 and the cite passage merely disclose a generic system 101 which may for

example include a television program guide. Nowhere does FIGURE 1 show a television or a TV screen and nowhere is it expressly stated or even suggested that the guide is displayed on a TV screen. In fact, nowhere is it even suggested that the guide is displayed at all. On the contrary, the guide merely exists in the database 111, and search results from a query of the guide are output as speech from the synthesizer 117.

Furthermore, merely disclosing that a television program guide exists is not the same as teaching the display of a program guide on a television. For example, consider the magazine "TV GUIDE." Clearly, this magazine includes a television program guide, but it does not then follow that the guide is somehow displayed on a television screen. Similarly, simply because a database may include a television program guide, it does not necessarily follow that the content of the database must be displayed on a television screen. On the contrary, it may, for example, be printed out to produce the aforementioned magazine, or as Polish expressly teaches, the content may be output as synthesized speech.

Finally, the Examiner seems to indicate that certain claim limitations may be deemed indefinite. Nevertheless, while the Examiner suggests that an indefiniteness rejection could possibly be made, he has in fact made no rejection on any such grounds. In any event, Applicants strongly disagree that any claimed step or element is indefinite. Merely because the claims may be broad, it does not mean they are indefinite. Moreover, regardless of the breadth of the claims, Polish still must disclose each and every claim element, and it does not.

CONCLUSION

For the reasons detailed above, it is respectfully submitted that all the claims remaining in the application are in condition for allowance. In the event the personal contact is considered advantageous to the disposition of this case, please telephone the below signed at the listed number.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

September 16, 2005

Date



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